

## REMARKS

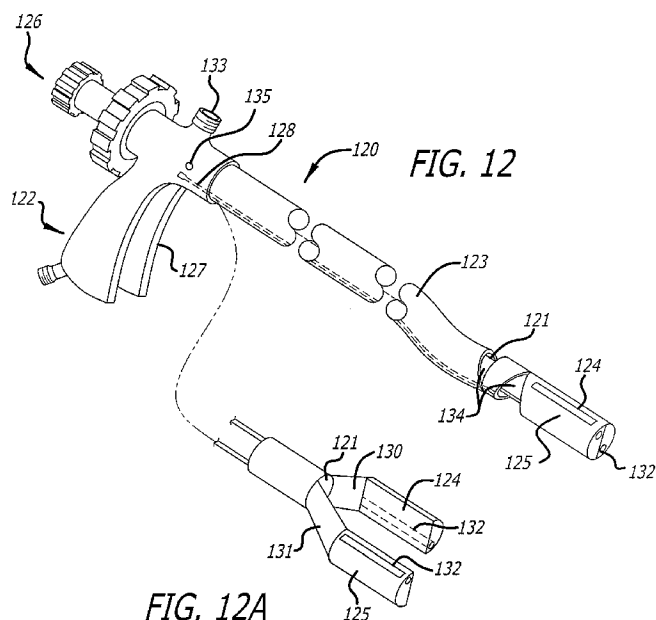
This Request for Continued Examination is responsive to the Final Office Action dated October 21, 2009. In the application Claims 1-19 and 26-29 are pending. In the Office Action, all of the pending claims are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon, U.S. Patent No. 5,542,949 (hereafter "Yoon"). Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon and in further view of Virnich, U.S. Patent N. 5,810,846. Applicant has carefully reviewed the arguments presented in the Final Office Action, and respectfully requests reconsideration of the pending claims in view of the remarks presented below.

### **Anticipation Under 35 U.S.C. §102**

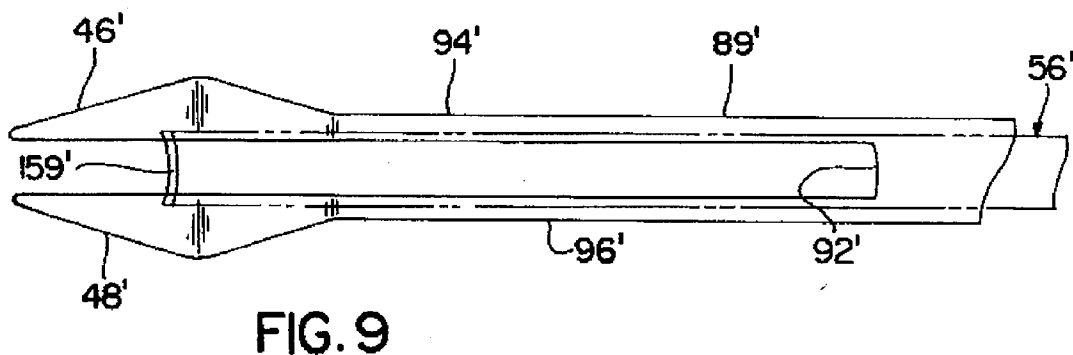
Claims 1-12, 17-19, 26, and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,542,949 ("Yoon"). Claim 1 is reproduced below:

1. A tissue acquisition device, comprising:  
an elongate main body having a proximal end, a distal end, and a length therebetween;  
a first jaw member and a second jaw member each pivotally connected to respective first and second hinge members,  
wherein the first and the second jaw members are adapted to scissor from a first configuration to a second expanded configuration, and  
wherein the first and the second jaw members each define an opening for acquiring tissue therewithin, each opening being in fluid communication with at least one lumen defined in the main body.

The second stanza of the body of the claim includes the following limitation: "the first and second jaw members are adapted to scissor from a first configuration to a second **expanded** configuration." Support for the scissoring motion can be found at paragraph 45, and Figures 12 and 12A, shown below." This is a particular type of motion that is not shown by Yoon nor capable by Yoon.



Claim 1 also recites the limitation wherein the first and second jaw members are connected to respective first and second hinges. This can also be seen in the figures above. Conversely, Yoon's "jaws" are simply two cantilevered ends that are not connected to respective first and second hinges as shown in the figure reproduced below. That is, there can be no argument that the jaws 46, 48 of Yoon are not connected to respective first and second hinges and does not meet the limitations of Claim 1.



### Rejection Under 35 U.S.C. §102

It is black letter patent law that anticipation under 35 U.S.C. §102 requires identity of invention: the claimed invention, as described in appropriately construed claims, must

be the same as that of the reference, in order to anticipate. Continental Can Co. USA, Inc. v. Monsanto Co. , 948 F.2d 1264, 1267, 20 USPQ2d 1746, 1748 (Fed.Cir. 1991); see also In re Spada , 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990) (“the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it”).

**Yoon, U.S. Patent No. 5,542,949**

Yoon discloses a clip applier instrument that describes a forceps jaws that can apply clips to tissue. An elongate tube **42** forces a pair of spring loaded jaws to pinch together, grabbing tissue. Note that the jaws of Yoon remain in apposition at all times, and do not "scissor" as required by Claim 1. Rather, the ends move apart and together by a proximal clamping force. As the Figure below shows, Yoon has two jaw members that simply pinch closed. Because Yoon's jaws do not satisfy Claim 1 as amended, the rejection for anticipation based on Yoon is improper and must be withdrawn. Further, as discussed above Yoon does not have respective first and second hinges connected to the jaw members. Rather, the jaws are simply cantilevered from a base to spring open and closed against the force of an outer tube. Because there are no hinges, Claim 1 limitations are not met.

The §102 rejection based on Yoon is the only rejection of Claim 1 in the Office Action. Applicant has demonstrated that the rejection is faulty and is properly withdrawn, rendering Claim 1 in condition for allowance. Because Claims 2 – 7, 10 – 19, and 26 – 29 depend directly or indirectly from Claim 1, by virtue of Claim 1's allowability these claims are necessarily also patentable over Yoon. Thus, all the pending claims are asserted to be in condition for allowance.

Applicant has demonstrated that all pending rejections cannot be sustained, and that the pending claims are in condition for allowance. Applicant respectfully requests early notification of same. If the Examiner believes that a telephone conference will

further the prosecution of this case, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is authorized to charge any deficiencies or fees in connection with this amendment to Deposit Account No. 06-2425.

Respectfully submitted,  
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